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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/602,688	06/25/2003	Bill Kitchen	23952-0032	1350

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SUTHERLAND II  
SUTHERLAND, ASBILL & BRENNAN, LLC  
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ATLANTA, GA 30309

EXAMINER
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ALVAREZ, RAQUEL

ART UNIT	PAPER NUMBER
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3688

MAIL DATE	DELIVERY MODE
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01/12/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/602,688	<b>Applicant(s)</b> KITCHEN ET AL.	
	<b>Examiner</b> Raquel Alvarez	<b>Art Unit</b> 3688	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 06 November 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 76-84, 86-94, 96-101, 103-108 and 110-113 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 76-84, 86-94, 96-101, 103-108 and 110-113 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

### DETAILED ACTION

1. This office action is in response to communication filed on 11/6/2008.
2. Claims 76-84, 86-94, 96-101, 103-108 and 110-113 are presented for examination.

#### **Claim Rejections - 35 USC § 103**

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 76-84, 86-94, 96-101, 103-108 and 110-113 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lawlor et al. (5,220,501 hereinafter Lawlor) in view of Bednar et al. (5,832,460 hereinafter Bednar).

With respect to claims 76, 86, 96-97, 103, 110-113 Lawlor teaches receiving, at a service provider from a consumer, a notification directive associated with a bill presentment option and a payment directive associated with an auto-pay option, wherein the notification directive and the payment directive are associated with a biller for the consumer (Figure 16A);

transmitting a notice of availability of the bill from the service provider to the consumer based upon the notification directive associated with the bill presentment option (Figure 9, 388);

automatically directing payment of the bill by the service provider on behalf of the consumer based upon the received bill information and the payment directive

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associated with the auto-pay option, wherein payment of the bill is automatically directed without the service provider receiving a specific request to pay the bill from the consumer (figure 16A).

With respect to receiving, at the service provider from the biller, bill information associated with a bill for the consumer. Lawlor teaches the service provider receiving from a consumer a list of bill information. Including payees information and payment information for each biller to be paid. Lawlor doesn't specifically teach the biller sending the bill information to the service provider. Bednar on the other hand teaches a method and system for bill presentation and payment reconciliation. The biller (i.e. bill originator 101) transmitting electronic bill 201 to service provider (i.e. electronic bill presenter 200). It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included the teachings of Bednar of receiving, at the service provider from the biller, bill information associated with a bill for the consumer because such a modification would save the customer money and time by having the biller send the billing information directly to the service provider.

Claims 77-79, 87-89, further recite automatically directing payment of the second bill by the service provider on behalf of the second consumer based upon the received second bill information and the second payment directive associated with the auto-pay option, wherein payment of the second bill is automatically directed without the service provider receiving a specific request to pay the second bill from the second consumer

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(i.e. the auto-pay options is available for multiple consumer and multiple billers)(Figure 16A).

With respect to claims 80, 90, Lawlor further teaches, wherein the first notification directive instructs the service provider to transmit notices of availability of bills from the first biller to the first consumer (see Figure 13), and wherein the second notification directive instructs the service provider to not transmit notices of availability of bills from the second biller to the second consumer (see figure 16A).

With respect to claims 81-84, 91-94, 98-101, 104-108 Lawlor further teaches wherein the bill is one of a plurality of future bills and identifies a period of time for the service to pay the future bills (See figure 14B) in an amount equal to a fixed amount and identifies a payment frequency for the service provider to pay future bills (Figure 17B).

With respect to claim 85, 95, Lawlor further teaches determining the biller account number based upon the received payment directive that does not include the biller account number (i.e. the customer user his userID and password to gain access to the biller's account information)(col. 36 ,lines 28-50).

### **Response to Arguments**

5. Applicant's arguments filed 11/6/2008 have been fully considered but they are not persuasive. Applicant argues that Lawlor doesn't teach presenting bills by a service provider to a consumer. The Examiner disagrees with Applicant because Figure 9,

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clearly teacher the user being presented by the service provider, a list of bills that can be paid.

6. Applicant argues that since in Lawlor the biller does not send bill information to the service provider, Lawlor cannot disclose presenting bills or transmitting notices of availability of bills by a service provider. The Examiner wants to point out that regardless of who submits the bills to the service provider, the service provider makes the bills available to the user in order to enable the customer to view bills, make changes to future transfer dates, etc. (see col. 15, lines 37-44).

7. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). The Examiner wants to point out that Bednar wasn't cited for notice of availability of bills or automatically directing payment of the bill by the service provider processor on behalf of the consumer based upon the received bill information and the pre-bill payment authorization. Instead, Lawlor was cited to teach those features and therefore, should be argued accordingly.

### **Conclusion**

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within

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TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

**Point of contact**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Raquel Alvarez whose telephone number is (571)272-6715. The examiner can normally be reached on 9:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James w. Myhre can be reached on (571)272-6722. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Raquel Alvarez/  
Primary Examiner, Art Unit 3688

Raquel Alvarez  
Primary Examiner  
Art Unit 3688

R.A.  
1/6/2009